APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,624	08/28/2003	Vincent C. Skurdal	200309874-1	7729

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EXAMINER
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ART UNIT	PAPER NUMBER
2136	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/650,624	SKURDAL ET AL.
	Examiner	Art Unit
	Brandon S. Hoffman	2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _03 August 2007_.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-26_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-26_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 are pending in this office action.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August

3, 2007, has been entered.

3.   Applicant's arguments, filed August 3, 2007, have been considered but are moot

in view of the new grounds of rejection.

Claim Rejections

4.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claim Rejections - 35 USC § 103

5.   Claims 1-12, 14-20, and 22-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Uchida (U.S. Patent No. 6,370,258) in view of Shaffer et al. (U.S.

Patent No. 6,434,579).

Regarding claims 1, 14, and 25, Uchida teaches a method/computer-usable

media/multifunction copier, the method comprising:

- A scanner (fig. 1, ref. num 201);

- A digitizer connected to the scanner (fig. 1, ref. num 210);

- A controller connected to the digitizer (fig. 1, ref. num 209); and

- A printer connected to the controller (fig. 1', ref. num 200);

Wherein the controller is adapted to cause the multifunction copier to perform a

method, the method comprising:

- Printing a control document containing a plurality of watermark images, each

  watermark image corresponding to watermark data using the printer (col. 2, lines

  29-33);

- Scanning printed material using the scanner; converting the printed material into

  data corresponding to the printed material using the digitizer (col. 3, lines 10-16);

  and

- Adding the watermark data corresponding to the selected watermark images to

  data corresponding to the scanned printed material to form data corresponding to

  watermarked material, wherein the watermarked material comprises the printed

material and the selected watermark images, **wherein the watermarked**

material does not include the first user mark (col. 3, lines 44-49); and

- Printing the watermarked material using the printer (col. 3, lines 51-58).

Uchida does not teach detecting a first user mark **in response to scanning the**

control document, the first user mark added to the control document after the control

document is printed **and corresponding to one of the watermark images, wherein**

detecting the first user mark selects the watermark image corresponding to the

first user mark.

Shaffer et al. teaches detecting a first user mark **in response to scanning the**

control document, the first user mark added to the control document after the control

document is printed **and corresponding to one of the watermark images, wherein**

detecting the first user mark selects the watermark image corresponding to the

first user mark (fig. 3-5 and col. 4, lines 28-40, col. 5, line 28 through col. 6, line 30).

It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to combine detecting a first user mark on a control document after

the control document has been printed and applying the selected sections of the first

user mark onto a printed material, as taught by Shaffer et al., with the

method/computer-usable media/multifunction copier of Uchida. It would have been

obvious for such modifications because scanning in a customers order with arranged

photos for a collage provides faster feedback and delivery of product than having to
send (by mail) the selected photos.

Regarding claims 10, 20, and 23, Uchida teaches a method/computer-usable
media/multifunction copier, the method comprising:

- Generating a **plurality of** thumbnail images from data stored in at least one of a
  memory of the multifunction copier and a removable memory removably
  connected to the multifunction copier, **each thumbnail image corresponding to
  a respective one watermark of a plurality of watermarks** (fig. 4 through fig. 7);

- Printing a control document containing the **plurality of** thumbnail images (col. 2,
  lines 29-33);

- Scanning printed material (col. 3, lines 10-16);

- Adding data corresponding to the selected watermark to data corresponding to
  the scanned printer material to form data corresponding to the watermarked
  material, wherein the watermarked material comprises the printed material and
  the image of the **selected** thumbnail images, **wherein the watermarked
  material does not include the first user mark** (col. 3, lines 44-49); and

- Printing the watermarked material (col. 3, lines 51-58).

Uchida does not teach scanning the control document to detect a first user mark
**added to the control document after the control document is generated and
corresponding to one of the thumbnail images, wherein detecting the first user**

mark selects the thumbnail image corresponding to the first user mark and thus

the watermark corresponding to that thumbnail image.

Shaffer et al. teaches scanning the control document to detect a first user mark

added to the control document after the control document is generated and

corresponding to one of the thumbnail images, wherein detecting the first user

mark selects the thumbnail image corresponding to the first user mark and thus

the watermark corresponding to that thumbnail image (fig. 3-5 and col. 4, lines 28-

40, col. 5, line 28 through col. 6, line 30).

It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to combine stuff, as taught by Shaffer et al., with the

method/computer-usable media/multifunction copier of Uchida. It would have been

obvious for such modifications because scanning in a customers order with arranged

photos for a collage provides faster feedback and delivery of product than having to

send (by mail) the selected photos.

Regarding claims 2 and 15, Uchida as modified by Shaffer et al. teaches further

comprising printing the watermarked material (see col. 2, lines 29-33 of Uchida).

Regarding claims 3 and 16, Uchida as modified by Shaffer et al. teaches wherein

printing the watermarked material is a result of detecting a second user mark

corresponding to a printing instruction in response to scanning the control document

(see col. 6, lines 9-23 of Uchida).

Regarding claims 4 and 17, Uchida as modified by Shaffer et al. teaches further

comprising sending the data corresponding to the watermarked material to one or more

destination addresses as a result of detecting one or more second user marks

respectively corresponding to the one or more destination addresses in response to

scanning the control document (see col. 6, lines 21-32 of Uchida).

Regarding claims 5 and 18, Uchida as modified by Shaffer et al. teaches further

comprising displaying the selected watermark **images** on the printed material according

to one or more display options as a result of detecting one or more second user marks

respectively corresponding to the one or more display options in response to scanning

the control document (see col. 6, lines 9-23 of Uchida).

Regarding claims 6 and 19, Uchida as modified by Shaffer et al. teaches wherein

adding the watermark data corresponding to the selected watermark images comprises

receiving the watermark data corresponding to the selected watermark images, as a

result of detecting the first user mark, from a removable memory removably connected

to the image processor (see col. 3, lines 52-59 of Uchida).

Regarding claim 7, Uchida as modified by Shaffer et al. teaches further

comprising placing the image processor in a watermarking mode of operation (see fig. 3

and col. 4, lines 19-25 of Uchida).

Regarding claim 8, Uchida as modified by Shaffer et al. teaches wherein placing

the image processor in the watermarking mode is in response to detecting an indicator

while scanning the control sheet or is in response to the user activating a watermark-

mode-selection key of the image processor (see fig. 4 and col. 4, lines 34-45 of Uchida).

Regarding claim 9, Uchida as modified by Shaffer et al. teaches wherein printing

the control document is in response to the user activating a control-document print key

of the image processor (see col. 3, lines 52-59 of Uchida).

Regarding claims 11, 22, and 24, Uchida as modified by Shaffer et al. teaches

further comprising, before printing the watermark control document, generating the

thumbnail images from data corresponding to the corresponding watermarks stored in

at least one of a memory of the multifunction copier and a removable memory

removably connected to the multifunction copier (see fig. 7 and col. 4, lines 46-63 of

Uchida).

Regarding claim 12, Uchida as modified by Shaffer et al. teaches wherein adding

the selected watermark to the printed material comprises adding data corresponding to

selected watermark that is stored in either a memory of the multifunction copier or a

removable memory removably connected to the multifunction copier to data

corresponding to the printed material (see fig. 7 of Uchida).

Regarding claims 13, 21, and 26, Uchida as modified by Shaffer et al. teaches

further comprising displaying the selected watermark **image** on the printed material

according to one or more display options as a result of detecting one or more second

user marks respectively corresponding to the one or more display options in response

to scanning the watermark control document (see fig. 4 of Shaffer et al.).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. U.S. Patent No. 6,922,779 to Lapstun et al., describes, at figures

1 and 2, that a document is printed with fields to be filled in by the user (control

document). As the user fills in the fields (user marks), the underlying document

transmits to the netpage system, the information that the user is filling in on the

document.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Brandon S. Hoffman whose telephone number is 571-

272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Hoffman/

BH

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10/11/07